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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,524	04/07/2000	Seth Haberman	08313808.12401	9763
545	7590	12/09/2009		
IP Patent Docketing K&L GATES LLP 599 Lexington Avenue 33rd Floor New York, NY 10022-6030			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 12/09/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/545,524	<b>Applicant(s)</b> HABERMAN ET AL.	
	<b>Examiner</b> IGOR BORISSOV	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Amendment received on 08/21/2009 is acknowledged and entered. Claims 1-12 have previously been canceled. Claims 15, 22, 26-34 have been amended. Claims 13-34 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 13-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (US 5,675,752) in view of Foresman et al. (US 5,099,422).**

Claims 13, 22 and 26.

Scott et al. (Scott) teaches:

receiving from an advertiser a request to create a customized video commercial (Fig. 5; C. 8, L. 63-65), said request comprising (a) identification of a target audience to whom said customized video commercial is to be distributed (airline passenger application, business training, schools programs, etc.), and (b) a sample (existing) video commercial comprising a plurality of sample video segments and a plurality of sample audio segments, wherein said sample video commercial has an advertising message (modifying existing programs C. 9, L. 9-59);

generating a video commercial template in response to receiving said request, said video commercial template comprising (a) a plurality of fillable video segment slots, each tillable video segment slot arranged at a specific time point within said video commercial template and (b) a plurality of fillable audio segment slots, each tillable

Art Unit: 3628

audio segment slot arranged at a specific time point within said video commercial template (C. 3, L. 22-30; C. 9, L. 1-8, 55-57);

storing in a resource library (a) a plurality of video segments, each video segment forming a portion of a complete video commercial and (b) a plurality of audio segments, each audio segment forming a portion of a complete video commercial (C. 3, L. 49-53);

defining one or more rules for filling said plurality of fillable video segment slots with said video segments and for filling said plurality of fillable audio segment slots with said audio segments (C. 3, L. 54-58; C. 9, L. 60-C. 10, L. 25; C. 18, L. 13-14);

filling said fillable video segment slots with said video segments and said fillable audio segment slots with said audio segments based on said defined rules (C. 3, L. 21-30);

distributing said customized video commercial to said target audience, wherein said customized video commercial has at least one of a video segment and an audio segment that is different from said sample video segment and sample audio segment respectively and wherein said customized video commercial has at least one video segment or audio segment that is the same as at least one of said sample video segment or sample audio segment (modifying existing programs C. 9, L. 57-59).

While Scott teaches creating a customized video commercial to be delivered to a target audience (airline passenger application, business training, schools programs), Scott does not specifically teach “defined characteristics which are to be acquired regarding said target audience”; “acquiring characteristics regarding said target audience from one or more sources”, and that said “defining one or more rules” step and “filling said tillable video segment slots” are conducted also based on said defined characteristics.

Foresman et al. (Foresman) teaches a method and system for distributing a customized video commercial, said customized video commercial including video and audio slots, said slots are filled into said customized video commercial based on defined and acquired from various sources characteristics regarding target audience and rules for filling said customized video commercial, wherein said rules are based on said

Art Unit: 3628

defined characteristics regarding target audience (C. 6, L. 20-27, 35-54; C. 7, L. 42-45; C. 5, L. 3-14; C. 7, L. 15-28; C. 1, L. 45-47).

It would have been prima face obvious to one having ordinary skill in the art at the time the invention was made to modify Scott to include: “defined characteristics which are to be acquired regarding said target audience”; “acquiring characteristics regarding said target audience from one or more sources”, and that said “defining one or more rules” step and “filling said tillable video segment slots” are conducted also based on said defined characteristics, as disclosed in Foresman, because it would advantageously allow to create prerecorded information segments selected to match the individual recipient's idiosyncracies, such as his or her needs and/or requirements, as specifically stated in Foresman (C. 3, L. 28-29), thereby increase return on advertising cost.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include as taught by B in the system of A, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 14 and 27. Said method wherein said resource library comprises video segments and audio segments created specifically for said customized video commercial (Scott; C. 9, L. 15-19).

Claims 15 and 28. Said method wherein said video commercial template further comprises:

at least one predefined video segment slot, each predefined video segment slot arranged at a specific time point within said video commercial template; said filling step further comprising each predefined video segment slot filling with sample video segment corresponding to said specific time point in said sample video commercial (Scott; (C. 3, L. 22-30; C. 9, L. 1-8, 55-57).

Claims 16 and 29. Said method wherein said video commercial template further comprises an animation slot arranged at a specific time point within said video commercial template (Scott; C. 9, L. 1-8).

Claims 17 and 30. Said method wherein said video commercial template further comprises an image slot arranged at a specific time point within said video commercial template (Scott; C. 9, L. 1-8).

Claims 18, 23 and 31. Said method wherein said characteristics regarding said target audience is acquired from a profile database (Foresman; C. 7, L. 24-46). The motivation to combine the references would be creating prerecorded information segments selected to match the individual recipient's idiosyncracies, such as his or her needs and/or requirements, thereby increase return on advertising cost.

Claims 19, 24 and 32. Said method wherein said characteristics regarding said target audience include demographics, address, monetary income, political affiliations, known preferences, buying patterns, or combinations thereof (Foresman; C. 6, L. 60 - C. 7, L. 10). The motivation to combine the references would be creating prerecorded information segments selected to match the individual recipient's idiosyncracies, such as his or her needs and/or requirements, thereby increase return on advertising cost.

Claims 20, 25 and 33. Said method wherein said customized video commercial is distributed to said target audience using a television distribution medium (Scott; C. 9, L. 30-31).

Claims 21 and 34. Said method wherein said distributing steep and said filling steps are carried out simultaneously (Scott; interactive presentation).

***Response to Arguments***

Applicant's arguments with respect to claims 13-34 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

12/06/2009